

REMARKS

In response to the Office Action dated December 13, 2001, claims 20 and 34 are amended. Claims 13-21 and 31-42 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 20, 32 and 34-42 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

As to claims 20 and 32, the Examiner maintains that the amounts of tantalum doped tin oxide in the exterior surface layer is disclosed in the specification only where the tin oxide is present with a binder layer.

As to claims 34-42, the Examiner maintains that the as-filed specification has no disclosure of “organic charge transporting material”.

To expedite prosecution, claim 20 is amended to depend from claim 14 and claim 34 is amended to change “an organic charge transporting material” to “a charge transporting material”. Consequently, withdrawal of the rejection of claims 20, 32 and 34-32 under 35 U.S.C. § 112, first paragraph, is respectfully solicited as the subject matter recited in amended claims 20 and 34 is fully described in the as-filed specification.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 13-21 and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rokutanzono et al. (hereinafter, Rokutanzono) in view of Bergmann et al. (hereinafter, Bergmann).

Claims 34-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rokutanzono in view of Bergmann, and further in view of *Organic Photoreceptors for Imaging Systems*, to Borsenberger, pp. 25-35 & 289-296.

The rejections are respectfully traversed.

As a first point, the present invention has a first unexpected result in that the photosensitive member of the present invention has stable photosensitivity with repeated use over a long period.

The present invention has a second unexpected result in that the photosensitive member of the present invention is capable of forming superior images without fogging, or producing unsharp images with repeated use over a long period.

Rokutanzono discloses a photosensitive member having a photosensitive layer and an exterior surface layer containing tin oxide doped with antimony. However, Rokutanzono **does not disclose** the exterior surface layer containing tantalum doped tin oxide. Further, Rokutanzono does not disclose the first and second unexpected results of the present invention.

Bergmann discloses conductive tantalum-doped tin oxide powder. However, Bergmann **does not disclose** the photosensitive member having the exterior surface layer

containing tantalum doped tin oxide. Further, Bergmann does not disclose the first and second unexpected results of the present invention.

While the Examiner maintains it would have been obvious to one having ordinary skill in the art to incorporate a tantalum doped tin oxide powder into the conductive layer of (the photosensitive member of) Rokutanzone because Bergmann discloses that conductive tantalum doped tin oxide powder is environmentally acceptable, such fact is an insufficient basis to predicate an assertion of obviousness.

It is submitted that Bergmann neither discloses nor suggests the desirability of making the modification suggested by the Examiner. None of the suggestions in Bergmann for use of the tantalum doped tin oxide powder pertains to using it in a photosensitive member.

It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the appellants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious under 35 U.S.C. 103. *Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated, 475 U.S. 809, 229 USPQ 478 (1986), aff'd. on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Recognizing, after the fact, that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967).

Applicants stress that the requisite motivation to support an obviousness conclusion is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or combine references *with a reasonable expectation of successfully achieving some particular realistic objective*. See, for example, *In re Gyurik*, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

Clearly, the only suggestion of using tantalum doped tin oxide for a surface layer of a photosensitive member is in the present application. However, Applicants' disclosure may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co., supra*. Therefore, a conclusion of obviousness is not warranted and it is urged that the rejection be withdrawn.

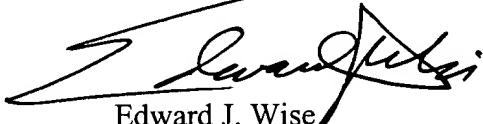
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:khb
Date: April 11, 2002
Facsimile: (202) 756-8087

VERSION WITH MARKINGS SHOWING CHANGES MADE

IN THE CLAIMS:

Please amend claims 20 and 34 as follows:

20. (Amended) The photosensitive member of claim [13] 14,

wherein a content of the tantalum doped tin oxide is 5 to 70 percentage-by-weight
of the total of the exterior surface layer.

34. (Amended) A photosensitive member comprising:

substrate;

a charge generating layer being formed on the substrate and containing an organic
charge generating material;

a charge transporting layer being formed n the charge generatng layer and
containing [an organic] a charge transporting material and a first binder resin; and

an exterior surface layer being formed on the charge transporting layer and
containing tantalum doped tin oxide and a second binder resin.